

Appeal No. 2022-1111

**IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

ETHICON LLC,

Appellant,

v.

INTERNATIONAL TRADE COMMISSION,

Appellee,

INTUITIVE SURGICAL, INC.,
INTUITIVE SURGICAL OPERATIONS, INC.,
INTUITIVE SURGICAL HOLDINGS, LLC,
INTUITIVE SURGICAL S. DE R.L. DE C.V.,

Intervenors.

Appeal from the United States International Trade Commission
in Investigation No. 337-TA-1167

**APPELLANT'S COMBINED PETITION FOR PANEL REHEARING
AND REHEARING *EN BANC***

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July 24, 2023

CERTIFICATE OF INTEREST

Counsel for the Appellant Ethicon LLC certifies the following:

1. Full name of every party represented by me:

Ethicon LLC.

2. The real name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

None.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

Johnson & Johnson.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

Weil, Gotshal & Manges LLP: Brian E. Ferguson, Robert T. Vlasis, Christopher T. Marando, Matthew Sieger, Daniel Musher, Audra Sawyer, Stephanie Adamakos, Ian A. Moore, Robert S. Magee.

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeals:

***Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, C.A. No. 1:18-cv-1325 (D. Del.);**

***Ethicon LLC et al. v. Intuitive Surgical, Inc. et al.*, C.A. No. 1:17-cv-0871 (D. Del.);**

***Intuitive Surgical Inc. v. Ethicon LLC*, Appeal Nos. 20-1480, 20-1482 (Fed. Cir.)**

***Intuitive Surgical Inc. v. Ethicon LLC*, Appeal No. 20-1481 (Fed. Cir.).**

6. Any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1 (c) (bankruptcy case debtors and trustees) is as follows:

Not applicable.

Dated: July 24, 2023

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RULE 40(a)(5) STATEMENT

The panel misapprehended the intrinsic evidence to find that the specification “make[s] clear” that a redundant construction is correct.

RULE 35(b)(2) STATEMENT

Based on my professional judgment, I believe the panel’s decision is contrary to at least the following decisions or precedents of this Court: *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364 (Fed. Cir. 2005) and *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1237 (Fed. Cir. 2016), *VLSI Tech. LLC v. Intel Corp.*, 53 F.4th 646 (Fed. Cir. 2022), and *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005).

Dated: July 24, 2023

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INTRODUCTION

This Court has long adhered to the principle that a “claim construction that gives meaning to all of the terms of the claim is preferred over one that does not do so.” *SSI Techs., LLC v. Dongguan Zhengyang Elec. Mech. Ltd.*, 59 F.4th 1328, 1335 (Fed. Cir. 2023) (cleaned up). A court may adopt a “disfavored” construction only when the “intrinsic evidence makes it clear” that it is the correct one. *VLSI Tech. LLC v. Intel Corp.*, 53 F.4th 646, 653 (Fed. Cir. 2022). The panel’s decision here is at odds with these bedrock principles. Not only did the panel adopt a construction that renders the claim language wholly superfluous, but its construction is expressly *contrary to* and otherwise ignores the specification and the intrinsic evidence. Compounding that error, the panel applied a rule that unduly disregards relevant intrinsic evidence in construing means-plus-function claims. Rehearing should be granted to realign the panel’s construction with this Court’s longstanding principles.

At issue in this petition is the construction of the term “means for guiding” in a patent directed to a laparoscopic surgical stapler. There is no dispute that “means for guiding” is a means-plus-function term subject to 35 U.S.C. § 112(f), and that the claimed function is “guiding the at least one lower foot on the firing element out of the proximal channel opening into the internal passage.” Appx471-474. Two disclosures in the specification describe the corresponding structure. Figures 40 and 41 depict “chamfer 6133” as a means for guiding (A “chamfer” is a sloped, flat

surface. *See* Op. 3 n.1.). And an accompanying description states that the means for guiding may “have a chamfer 6133 thereon *or otherwise be sloped* as shown.” Appx418, 77:33-34 (emphasis added).

Taken together, the plain meaning of these disclosures is clear: the “means for guiding” could be a flat-sloped chamfer as depicted in Figures 40 and 41, or it could “otherwise be sloped”—*i.e.*, sloped in some other way, such as curved. The panel (and a divided Commission below), however, rejected this plain meaning, concluding that the “means for guiding” described in the specification must be flat and “does not include curved surfaces.” Op. 4.

The panel’s construction upends fundamental claim construction principles. At the jump, the construction raises a red flag: it renders the language “or otherwise be sloped” entirely superfluous. All agree that a “chamfer” is flat-sloped. But the panel read the alternative language, “or otherwise be sloped,” to also mean flat-sloped. In other words, the language reduces to “may have a flat slope or otherwise be flat sloped.” That makes non-sense of the disclosure; it gives the phrase “or otherwise be sloped” no additional meaning; and it is entirely redundant. The panel appeared to recognize this problem, *see* Op. 5, but its attempt to justify its construction nonetheless unsettles longstanding precedent—for at least two reasons.

First, the panel purported to rely on the specification, but its construction plainly contradicts—rather than finds “clear” support in—the relevant disclosures.

The disclosure states that the “means for guiding” may be “otherwise” sloped—*i.e.*, sloped in some different way—as compared to a chamfer. But the panel concluded that the “means for guiding” not only could be—but *must* be—sloped *in the same way* as the chamfer. In other words, the panel’s construction does not just render the “otherwise be sloped” language meaningless; the construction is in fact *contrary to* that disclosure. The panel’s reliance on the surfaces shown in Figures 40 and 41, which it found “are incontrovertibly flat,” Op. 4, does not help. The figures unambiguously depict only “chamfer 6133” (*see* Appx329); they do not depict a “means for guiding” that is “otherwise” sloped in comparison to chamfer 6133. Moreover, the specification’s reference to “as shown” does not refer to the *slope* of the chamfer in those figures—if it did, that would read out of the specification the alternative that is plainly disclosed. So, these figures do not support—much less “clearly” support—the panel’s holding that the means for guiding must be flat.

Second, the panel’s opinion improperly disregards relevant intrinsic evidence in construing this means-plus-function claim. Several additional pieces of intrinsic evidence undercut—rather than confirm—that the panel’s “disfavored” construction is the correct one. For example, dependent claim 23—an original claim in the application, and thus part of the specification—provides that the corresponding structure “comprises at least one ramped surface.” Appx426, 94:26-30. The specification further confirms that a “ramped surface” can comprise “curved

surfaces.” Appx392, 26:11-15. And the specification elsewhere makes clear that a “sloped” surface may include curved surfaces. Appx392, 25:17-20, 26:13-15.

The panel put aside this evidence, however, reasoning that these disclosures are “unrelated” to the claimed “means for guiding” and therefore do not describe the corresponding structure. Op. 4. This holding misses the point—and further contravenes this Court’s cases. As this Court has confirmed “[c]onsistent use of a term in a particular way in the specification can inform the proper construction of that term.” *Wi-LAN USA, Inc. v. Apple Inc.*, 830 F.3d 1374, 1382 (Fed. Cir. 2016). Here, these additional disclosures inform what the inventors meant by “ramped” and “sloped” throughout the specification, even when the terms are used to describe other features of the invention. Indeed, no party disputes that the plain and ordinary meaning of ramped surface encompasses sloped surfaces. By entirely discarding this evidence here, the panel applied a rule that improperly disregards pertinent and informative intrinsic evidence—an error that magnifies the panel’s erroneous adoption of a “disfavored” construction in the first place. Rehearing should be granted to reaffirm the consistent application of these bedrock claim construction principles.

BACKGROUND

I. The Claimed Invention

A. Laparoscopic Staplers

Ethicon develops surgical staplers that simultaneously cut and staple tissue in minimally invasive surgeries, including laparoscopic surgeries. In laparoscopic surgery, the surgeon makes small incisions and inserts surgical tools, such as staplers and cameras, to access, view, and operate on the patient. *See* Appx3135. Examples of Ethicon's handheld Echelon Flex Powered Plus Stapler and its 60mm stapler prototype for use with a robotic system are depicted below.



Appx2001



Appx1925

These surgical staplers include an end effector with two jaws. A staple cartridge is inserted into one of the jaws, typically referred to as the reload channel or channel. The jaws are closed around the desired tissue. Once closed, a firing element slides from the proximal end (the near end, closer to the shaft) to the distal end (away from the shaft) of the jaws. *See, e.g.,* Appx380, 1:27-37; Appx212, 2:8-12; *see also* Appx2402 at Q/A 16, 17. The firing element advances a sled to eject staples into the tissue, and a knife that cuts the tissue. *See, e.g.,* Appx380, 1:27-37; Appx212, 2:8-12. The sled drives the staples upwards towards the opposite jaw, forming

staples on either side of a cut line while the knife lags behind the sled and cuts tissue along the same line. In this way, the stapler simultaneously cuts and seals the tissue.

B. Ethicon's '369 patent

This is an appeal from the Commission's decision finding noninfringement of claims 22 and 23 of Ethicon's U.S. Patent No. 9,844,369 ("the '369 patent"), which turns entirely on the construction of the means-plus-function term "means for guiding." Claim 22 is representative and is directed to a "surgical end effector, comprising," in relevant part:

an elongate channel ...;

a firing element ... including a vertical portion and at least one laterally extending lower foot;

an internal passage ...;

a proximal channel opening ...; and

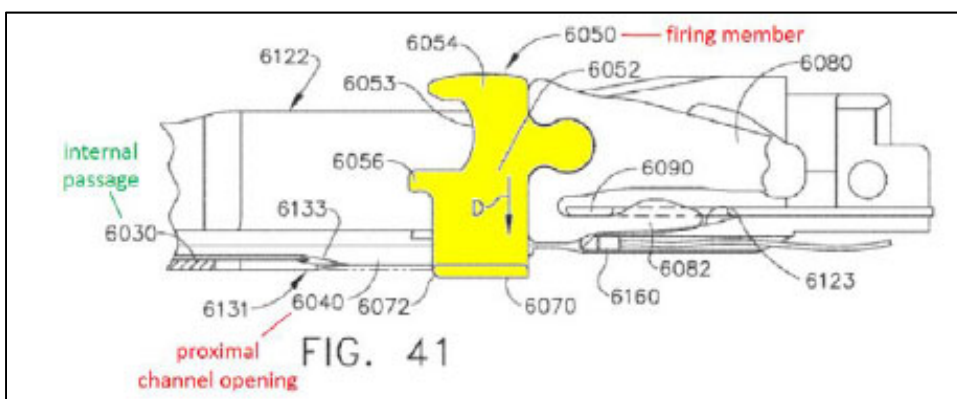
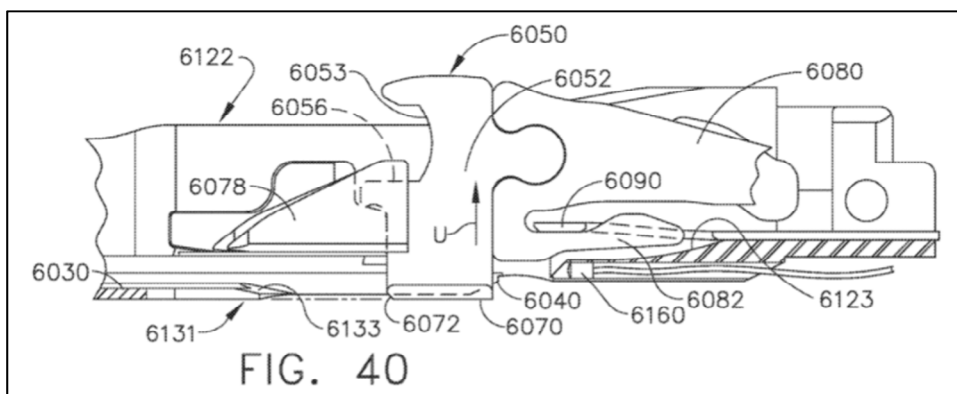
means for guiding the at least one lower foot on the firing element out of the proximal channel opening into the internal passage upon initial application of a firing motion to the firing element.

Appx426, 94:1-25 (emphasis added).

The parties agree that the "means for guiding" term is a means-plus-function limitation, and that the claimed function is "[g]uiding the at least one lower foot on the firing element out of the proximal channel opening into the internal passage upon initial application of a firing motion to the firing element." Appx44.

Figures 40 and 41 depict an exemplary embodiment that uses chamfers to perform the claimed function. It is undisputed that a "chamfer" requires a flat (*i.e.*,

constant sloped) surface. Appx1603, 736:13-17. The figures show chamfer 6133 located on “the proximal end 6131 of the internal passage 6030,” and chamfer 6072 on the foot of the I/E-beam highlighted in yellow. Appx418, 77:24-34.

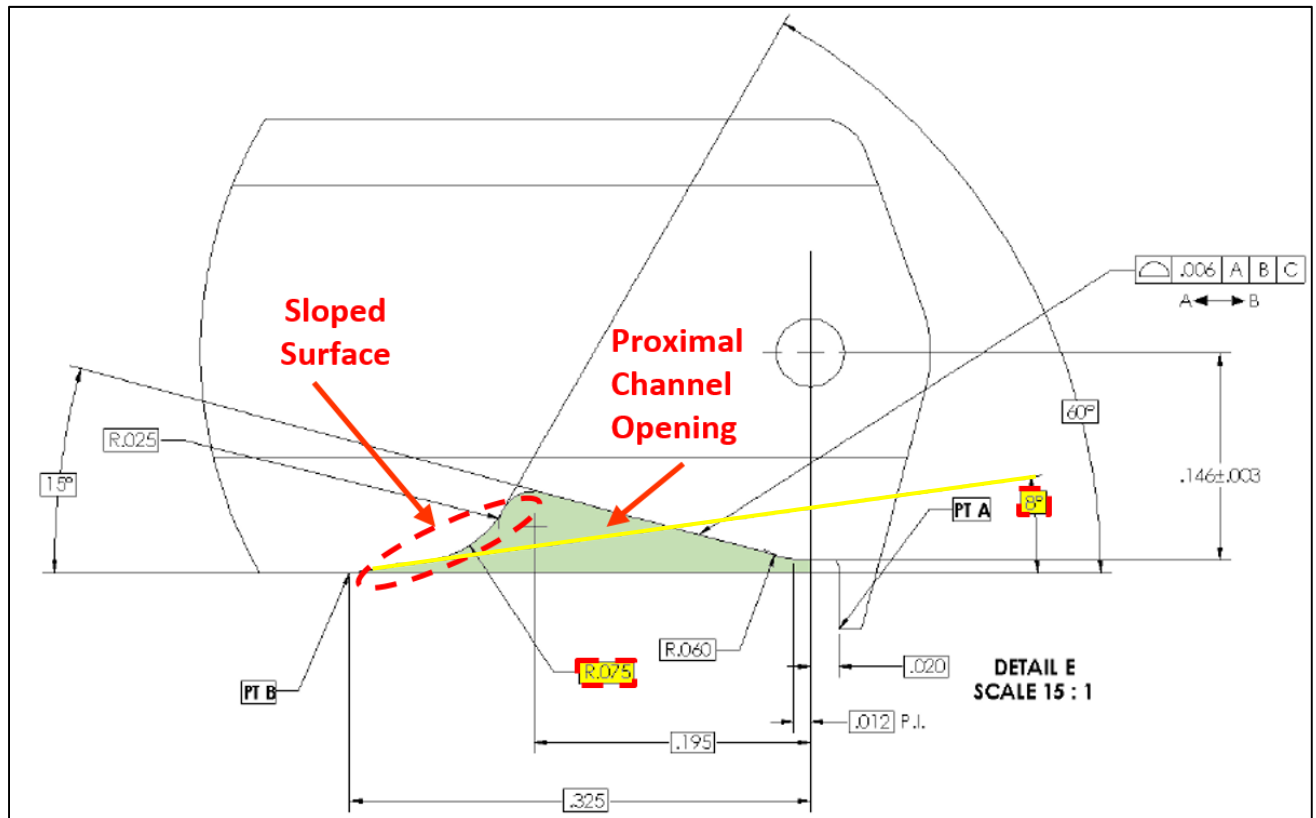


Appx329, Fig. 41 (annotated).

When on the foot, “chamfers 6072 form small ‘lead-in’ ramps which help to guide the feet 6070 [of the beam] into the passage 6030.” Appx418, 77:29-31. When on the proximal end 6131 of the internal passage 6030, the guiding structure may “have a *chamfer 6133 thereon or otherwise be sloped as shown.*” Appx418, 77:33-34 (emphasis added).

II. The Accused SureForm

The accused product is Intuitive's SureForm Stapler. The SureForm, in relevant part, includes a sloped surface on the proximal channel opening, which the parties agree performs the function of guiding the lower foot of the SureForm's I-beam out of the proximal channel opening and into an internal passage. Appx2268-2270 at Q/A 101-110. As depicted by Intuitive's mechanical part drawing, the sloped surface includes a curved surface (radius of 0.075) and a flat surface (slope of 8°) that leads into the internal passage. See Appx2269-2270 at Q/A 104, 108; Appx3483-3485 at Q/A 59, 62.



Appx2019 (annotated).

III. Procedural History

A. The ALJ's Initial Determination

The ALJ agreed with Ethicon that the corresponding structure of “means for guiding” is “a chamfer or otherwise sloped surface on the at least one lower foot and/or on the elongate channel.” Appx472. The ALJ rejected Intuitive’s argument that the corresponding structure was limited only to flat surfaces (chamfers) and instead held that it includes “otherwise sloped surface[s]” like curved slopes because any other reading would render the “otherwise be sloped as shown” language meaningless. Appx471-476. Accordingly, the ALJ issued an initial determination finding that the SureForm literally infringes claims 22 and 23 of the ’369 patent because the lead-in ramp on the proximal channel opening of the SureForm satisfied the claimed structure and function. *See, e.g.*, Appx554-562.

B. The Commission's Decision & Vice Chair Stayin's Dissent

The Commission reversed the ALJ’s finding of infringement, over a partial dissent by Vice Chair Stayin, denying relief as to the ’369 patent. First, the Commission reversed the ALJ’s construction of “means for guiding,” instead determining that the corresponding structure is “limited to flat surfaces.” Appx50. The Commission reasoned that the corresponding structure must be flat because the specification discloses “a surface that is chamfered ‘or otherwise sloped *as shown*’ in Figures 40 and 41,” and those figures show only flat surfaces. Appx49. Accordingly, the Commission concluded that the SureForm did not infringe under

its construction because the additional curved portion of the lead-in ramp “negated” the claimed feature and prevented infringement. Appx51-59.

Vice Chair Stayin dissented in relevant part. He indicated that the Commission’s construction requiring a flat surface was “overly narrow” and that, “properly construed, the ‘means for guiding’ limitation reads on the sloped surface of the SureForm products as found by the ID.” Appx43 & n.13.

C. The Panel’s Decision

The panel affirmed. As relevant to this petition, the panel acknowledged that Ethicon had argued that the “Commission’s construction renders meaningless the specification phrase “otherwise sloped” and further noted that “a construction that introduces redundancy into a claim is disfavored.” Op. 5 (quoting *VLSI Tech.*, 53 F.4th at 653). But, the panel held, such redundant constructions are “not foreclosed,” observing “that is particularly true where . . . intrinsic evidence makes it clear that the ‘redundant’ construction is correct.” *Id.* The panel found that here, “the specification makes clear that the only surfaces it associates with the ‘means for guiding’ are not curved, that is, the flat, sloped chamfer 6133 and the plainly flat, sloped surface ‘shown’ in Figure 40 and 41.” *Id.*

The panel also acknowledged that Ethicon had identified portions of the specification that describe sloped or ramped surfaces as having curves—including in dependent claim 23’s recitation of the “means for guiding.” Op. 4. But the panel

discounted this evidence because the discussions were “completely unrelated to the claimed ‘means for guiding’ and therefore do[] not describe structure corresponding to the ‘means for guiding.’” *Id.* Accordingly, the panel found that the structure corresponding to the “means for guiding” is flat and “does not include curved surfaces.” *Id.*

ARGUMENT

I. The Panel Decision Conflicts with Circuit Precedent

This Court has repeatedly held that “[a] claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.” *SSI Techs., LLC v. Dongguan Zhengyang Elec. Mech. LTD.*, 59 F.4th 1328, 1335 (Fed. Cir. 2023); *see also In re Power Integrations, Inc.*, 884 F.3d 1370, 1376 (Fed. Cir. 2018) (same, rejecting a construction that “renders claim language meaningless”); *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (same). As this Court has put it, “[i]deally, claim constructions give meaning to all of a claim’s terms.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1237 (Fed. Cir. 2016). A court may adopt a “disfavored” construction that introduces redundancy only when the “intrinsic evidence *makes it clear* that the ‘redundant’ construction is correct.” *VLSI Tech.*, 53 F.4th at 653 (emphasis added).

The panel’s opinion violates this cardinal rule and this Court’s clear-statement exception. The construction adopted by the panel not only renders key claim

language meaningless, but is in fact contrary to the plain language of the specification. The panel did not identify any intrinsic evidence—much less “clear” evidence—supporting its “disfavored” construction, aside from the claim language that gives rise to the redundancy itself. And, making matters worse, the panel adopted and applied a rule that disregarded the intrinsic evidence that squarely *undermined* its construction. Rehearing is warranted to realign the panel’s analysis with this Court’s settled precedent.

A. The Panel Departed From Settled Precedent In Adopting A Redundant Construction Without Clear Intrinsic Evidence That It Is The Correct Construction

The question here is the proper construction of the claimed term “means for guiding,” which the parties agree is a means-plus-function term. For means-plus-function terms, the claimed structure is defined by the portions of the specification that are associated with the claimed function. 35 U.S.C. § 112(f). Those parts of the specification are effectively part of the claim language. Here, Figures 40 and 41 (which depict, *inter alia*, chamfer 6133) and the phrase “have a chamfer 6133 thereon or otherwise be sloped as shown” are associated with the claimed function. Appx418, 77:33-34. Thus, the claimed “means for guiding” may be either “chamfer 6133,” *i.e.*, a continuously flat surface; “*or*,” it may “*otherwise be sloped*,” *i.e.*,

sloped in a different way, such as curved.¹ This construction gives meaning to every word in the phrase, consistent with this Court’s guiding principles.

The panel’s construction violates these principles. The panel held that the claimed “means for guiding” could *only* be flat—notwithstanding the clear disclosure that it could “*otherwise* be sloped” in comparison to the “incontrovertibly” flat chamfer 6133. Op. 4-5. Not only does this construction render the phrase “otherwise be sloped” meaningless, it directly contradicts that language. The disclosure clearly indicates that the means for guiding could be a flat-sloped chamfer, or it could “otherwise be sloped”—that is, sloped in some *different way* from a chamfer. But the panel’s construction held that the means for guiding *must* be flat-sloped—that is, sloped in the *same way* as a chamfer. This construction is therefore not only nonsensical, it is at odds with the specification.

If the panel were to adopt such a “disfavored” construction, this Court’s cases required it to identify intrinsic evidence that “makes clear” that its construction is the correct one. The panel did not do so. The panel pointed to Figures 40 and 41, which it found show “incontrovertibly flat” surfaces. Op. 5. But those figures expressly and unambiguously illustrate “chamfer 6133”; they do not illustrate the alternative “means for guiding” that is also described in the specification as

¹ See Webster’s Third New International Dictionary (2002) (“Otherwise” means “in a different way or manner”).

“otherwise” sloped. Nor does the specification’s reference to “as shown” refer to the *slope* of the chamfer in those figures—if it did, that would read out of the specification the alternative that is plainly disclosed. So, the figures do not “make clear” that the panel’s construction is correct, notwithstanding the redundancy it creates.

In adopting that construction anyway, the panel engaged in circular logic: it used the figures to create the redundancy (in contravention to the disclosure’s plain language); and then relied on the figures as intrinsic evidence to justify the redundant construction. But in the narrow circumstances in which this Court has sanctioned constructions that fail to give meaning to all terms, this Court has insisted on “clear” evidence *other* than the very evidence that gives rise to the redundancy. *See, e.g., SimpleAir, Inc. v. Sony Ericsson Mobile Commc ’ns AB*, 820 F.3d 419, 429 (Fed. Cir. 2016). Were it otherwise, the exception would swallow this cardinal rule of claim construction.

B. The Panel Adopted An Erroneous Rule To Disregard Intrinsic Evidence Illuminating the Meaning Of Disputed Claim Terms

Making matters worse, the panel adopted a rule that allowed it to cast aside the other intrinsic evidence in the specification that *contradicts* its construction. This evidence showed that a means for guiding can be curved or flat. Specifically, dependent claim 23, which was originally claim 24 in the application for the ’369 patent, recites that “means for guiding comprises at least one *ramped surface*...”

Appx426, 94:26-30; Appx5324. And the specification elsewhere states that *sloped* and *ramped surfaces* “can comprise one or more flat surfaces, *curved surfaces*, concave surfaces, and/or convex surfaces, for example.” Appx392, 25:17-20, 26:13-15 (emphasis added). Indeed, no party disputes that the plain and ordinary meaning of ramped surface encompasses sloped surfaces. *See, e.g.*, Appx1910, ¶ 16. (“[A POSITA] would understand that while a chamfer is an example of a ‘ramped surface,’ a ‘ramped surface’ is not limited to a chamfer, and instead encompasses other types of sloped surfaces.”); Appx2881-2882 (Intuitive identifying a rounded surface as a ramped surface); Appx2973-2974, ¶ 114 (same); Appx2974-2975, ¶ 115 (similar). This evidence shows that the inventors used the terms “ramped” and “sloped” to refer to surfaces that were curved as well as flat.

The panel disregarded this evidence, reasoning that because certain of these additional disclosures were “unrelated” to the claimed function, they could not inform the meaning of the disputed means-plus-function term. But this ruling is squarely at odds with this Court’s precedent—and unduly cramps the use of intrinsic evidence in construing means-plus-function terms. As this Court has recognized, “[b]ecause claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005); *see also Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001) (“[A]

claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent.”).

Construing a means-plus-function term is no different. That is, the inventors’ use of the term “ramped” and “sloped” with respect to one claim can—or even should—inform the use of those same terms elsewhere in the disclosure, including as it relates to a claimed function. In holding otherwise—that intrinsic evidence of term usage is only relevant if it relates to the claimed function—the panel veered from settled precedent and unreasonably limited the use of such evidence in construing means-plus-function claims.

II. Correcting the Conflict With Settled Precedent Is Important

Rehearing is warranted to realign the panel’s decision with this Court’s fundamental claim-construction precedents. This Court has consistently emphasized that claims ought to be construed to give meaning to every term and avoid redundancy unless such a “disfavored” construction is clearly provided by the extrinsic evidence. This rule ensures consistency and predictability in understanding patent claims by courts, practitioners, litigants, and the public. It also remains faithful to the patentee’s disclosures and attempts to give full meaning to the scope of their invention. As discussed above, the panel’s decision erodes that settled law, inviting confusion and uncertainty in the claim construction analysis. It sustains what it acknowledges is a construction that renders key claim language meaningless, and

it does so in the absence of clear intrinsic evidence supporting that unnatural construction. Rehearing should be granted so this Court can reaffirm these bedrock principles of claim construction.

CONCLUSION

For the foregoing reasons, Ethicon's petition should be granted.

Dated: July 24, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on July 24, 2023, I filed or caused to be filed a copy of APPELLANT'S COMBINED PETITION FOR PANEL REHEARING AND REHEARING *EN BANC* with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system and served or caused to be served a copy on all counsel of record by the CM/ECF system and email.

Dated: July 24, 2023

/s/ Zachary D. Tripp

Zachary D. Tripp

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the type-volume limitations of Fed. R. App. P. 40(b). This brief contains 3,458 words as calculated by the “Word Count” feature of Microsoft Word 2016, the word processing program used to create it, excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b)(2).

The undersigned further certifies that this brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Times New Roman 14 point font.

Dated: July 24, 2023

/s/ Zachary D. Tripp

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