

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CYTONOME/ST, LLC,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 19-301 (RGA)
)	
NANOCELECT BIOMEDICAL, INC.,)	
)	
Defendant.)	

LETTER TO THE COURT REGARDING CLAIM CONSTRUCTION

OF COUNSEL:

Kirt S. O'Neill
Daniel L. Moffett
AKIN GUMP STRAUSS HAUER & FELD LLP
112 E. Pecan Street, Suite 1010
San Antonio, TX 78205
(210) 281-7000

Thomas W. Landers IV
AKIN GUMP STRAUSS HAUER & FELD LLP
1111 Louisiana Street, 44th Floor
Houston, TX 77002
(713) 220-5800

MORRIS, NICHOLS, ARSHT & TUNNELL LLP
Rodger D. Smith II (#3778)
Anthony D. Raucci (#5948)
1201 North Market Street
P.O. Box 1347
Wilmington, DE 19899
(302) 658-9200
rsmith@mnat.com
araucci@mnat.com

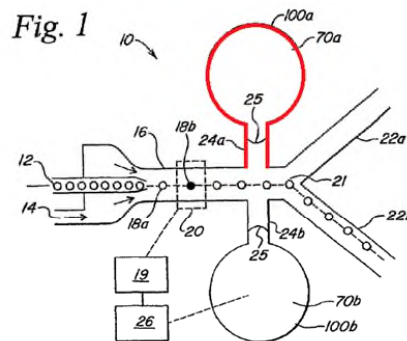
Attorneys for Plaintiff Cytonome/ST, LLC

May 13, 2020

Dear Judge Andrews:

Pursuant to the Court's orders from the April 28, 2020 *Markman* hearing (D.I. 81), Plaintiff Cytonome/ST, LLC hereby submits (1) a supplemental expert declaration regarding "pressure pulse" (attached as Exhibit A); and (2) Plaintiff's proposal for construing the term "buffer."

At the briefing stage, Plaintiff proposed construing the term "buffer" as "a physical structure that contains fluid and receives a pressure pulse" based on the intrinsic record's description of a "buffer" as a type of reservoir that absorbs a pressure pulse. D.I. 66 at 27–29, 32–37, 40–44. Plaintiff avoided using the terms "reservoir" and "absorbs" in its construction in part because those terms were themselves in dispute at the time. *See, e.g., id.* at 8, 69–70; D.I. 81 at 18:1–19:14. Defendant, on the other hand, originally contended that the term "buffer" was either indefinite or a "mean-plus-function" limitation subject to 35 U.S.C. 112 ¶ 6. *Id.* at 27, 29–32, 37–44, 81–83. Specifically, Defendant sought to limit "buffer" to a particular structure from a single embodiment, namely gas-filled reservoir 70a at the terminus of side channel 24a, depicted below in Figure 1 of the '850 Patent:



'850 Patent, Fig. 1 (annotated); *see also* '528 Patent, Fig. 16 (components 174b and 70).

At the *Markman* hearing, the Court rejected both of Defendant's arguments, finding that "buffer" was not indefinite and that "buffer" was not limited to the above gas-filled reservoir embodiment based on 112 ¶ 6. D.I. 81 at 30:19–31:19.

The Court declined to adopt Plaintiff's construction, however, citing two specific concerns. First, the Court was concerned that Plaintiff's original construction "doesn't really seem to go to the essence of what a buffer is." *Id.* at 18:20–22. The Court observed that "the essence of what a buffer is" is "not that it *receives* a pressure variation, but that it *absorbs* it." *Id.* at 18:1–8 (emphasis added) (referring to an excerpt from the '528 Patent's prosecution history describing a "reservoir or buffer for absorbing a pressure variation" (*see* D.I. 67 at 40)). Second, the Court was concerned that the phrase "physical structure" was a "non-description." *Id.* at 14:3–7.

To address those two concerns, Plaintiff now proposes a slightly modified version of its original construction, namely that "buffer" means "a reservoir of fluid that absorbs a pressure pulse." This directly addresses the Court's concerns by (a) substituting the word "absorbs" for

“receives,” and (b) replacing “physical structure” with a more descriptive term, “reservoir.” The Court suggested that this new terminology, taken from a “piece of prosecution history,” could provide “a much better definition of a buffer” than what Plaintiff originally proposed. *Id.* at 18:1–8 (referring to D.I. 67 at 40); *see also id.* at 14:3–7, 18:20–22.

This modified terminology is not a substantive change from Plaintiff’s original construction. Indeed, Plaintiff originally proposed using “physical structure” and “receives” specifically because it considered those terms synonyms for the formerly-disputed “reservoir” and “absorbing” terms. *See* D.I. 66 at 10 (agreeing that “absorbing” means to “receive”), 69 (proposing to construe “reservoir” as “a *physical structure* that contains fluid”), 34–35 (demonstrating that “buffer” was used “interchangeably” with “reservoir” during prosecution). Plaintiff was simply trying to avoid having a disputed term embedded in a construction. But the disputes over those two terms have been resolved. D.I. 81 at 34:4–19 (declining to construe “reservoir”), 42:17–43:6 (same for “absorbing”).

Plaintiff’s new proposal remains consistent with the intrinsic record for all the reasons provided in its briefings. D.I. 66 at 27–44. For example, claim 1 of the ’850 Patent recites “a buffer configured to *fluidically* co-operate with the actuator,” which suggests that the buffer and actuator reservoirs contain “fluid” that allows them to cooperate with respect to applying and absorbing the pressure pulse. *See also* ’528 Patent, claims 15, 18, 22; ’850 Patent, claims 1, 12 (describing a buffer “for absorbing” the pressure pulse dispatched from the actuator). The specifications similarly describe a “buffer” as a type of reservoir that is filled with “fluid” and “allow[s] the pressure pulse to be absorbed.” ’850 Patent at 7:28–37; *see also id.* at 4:14–16, 6:9–45, 9:48–56; ’528 Patent at 12:27–34. As the Court recognized, Plaintiff’s modified construction is even more consistent with the intrinsic record than its original construction because the modified construction uses terminology directly from the prosecution history. *See* D.I. 81 at 18:1–8.

Defendant, on the other hand, now seeks an entirely new construction based on a new legal theory, once again attempting to limit “buffer” to the single gas-filled reservoir embodiment. Defendant proposes construing “buffer” as “a reservoir of *compressible* fluid, configured for absorbing the pressure pulse.” Ex. B at 2 (emphasis added). While this may seem like a minor change on its face, the true purpose behind the construction was made clear by Defendant’s counsel at the *Markman* hearing. Specifically, Defendant’s position is that, while “fluid” generally refers to liquids *and* gases, “in this instance, *it has to be a gas*” and “you need to have a compressible fluid *which is a gas* sitting in that bubble valve . . . in order to absorb or dampen that [pressure pulse].” *Id.* (emphasis added). While Plaintiff disagrees with the premise that liquids cannot be compressible fluids,¹ Defendant’s attempt to narrowly limit “buffer” to a gas-filled reservoir is inconsistent with the intrinsic record and amounts to a brand-new “specification disclaimer” argument that requires an extremely high bar—one that clearly cannot be reached here.

¹ As Dr. Vacca explained in his original declaration, one means of configuring a buffer to “absorb” is to “partially fill the reservoir” with “a more compressible liquid.” D.I. 67, Ex. H ¶ 52. Defendant’s construction will likely invite a “battle of the experts” over this issue.

Defendant's construction would improperly exclude embodiments disclosed in the '528 and '850 Patents that do not employ a gas-filled reservoir. For example, both patents describe embodiments where the buffer reservoir is "a chamber *having a resilient wall or contains a compressible fluid* such as a gas." '528 Patent at 12:30–32 (emphasis added); '850 Patent at 7:31–33. The specifications thus make it abundantly clear that containing a compressible fluid is but *one option* for designing the claimed buffer. Additionally, the '850 Patent describes buffers that "absorb" by adjusting the "spring constant" of the buffer reservoir, namely by "varying the volume of the buffer chamber 70b, the cross-sectional area of the side passage 24b and/or the stiffness or the thickness of a flexible membrane (reference 72 in FIG.7) forming the buffer chamber 70b." '850 Patent at 9:51–56. Like the "resilient wall," these adjustments allow a buffer to absorb without *necessarily* filling the reservoir with gas. *See also* D.I. 67, Ex. H ¶¶ 51–54 (Dr. Vacca explaining various adjustments a person of skill could make to a "buffer" to allow it to "absorb"). Defendant's construction improperly excludes all such embodiments.

Further evidence that the claimed "buffer" should not be limited to a gas-filled reservoir per Defendant's interpretation of "compressible fluid" is found in the claims themselves. When the inventors wanted to limit the buffer reservoir to a particular fluid, they did so explicitly. For example, dependent claim 26 of the '850 Patent recites that "the buffer comprises air trapped in a sealed reservoir." On the other hand, dependent claim 24 does not specify a type of fluid but limits the buffer to employing a "flexible membrane"—a design the specifications expressly describe as an *alternative* to a gas-filled buffer. *See* '528 Patent at 12:30–32; '850 Patent at 7:31–33.

Finally, by relying on a single embodiment in the specification to seek a construction that is inconsistent with the claims and the remainder of the specification, Defendant is effectively asking the Court to find a "specification disclaimer." Such a disclaimer, however, requires "clear and unmistakable" language in the specification that expressly disavows claim scope. *See Thorner v. Sony Comput. Entm't Am. LLC*, 669 F.3d 1362, 1367 (Fed. Cir. 2012) (explaining that even "direct criticism" does not invoke specification disclaimer). No such disclaimer exists here. Defendant's evidence of specification disclaimer boils down to a single embodiment that discloses a gas-filled reservoir and does not in any way exclude or disparage other embodiments. Indeed, even if the gas-filled reservoir were the *only* embodiment, it would not amount to a disclaimer. *Id.* (explaining that it is "not enough that the only embodiments, or all of the embodiments, contain a particular limitation" because the Court "do[es] not read limitations from the specification into claims"). The Court should therefore reject Defendant's proposed construction.

Respectfully submitted,

/s/ *Anthony D. Raucci*

Anthony D. Raucci (#5948)

w/att.

cc: All Counsel of Record (w/att. – via e-mail)