

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

BECTON DICKINSON AND COMPANY, )

Plaintiff, )

v. )

TYCO HEALTHCARE GROUP LP, )

Defendant. )

Civil Action No. 02-1694 GMS

**ORDER**

1. The plaintiff, Becton, Dickinson and Company (“BD”) filed the above-captioned action against Tyco Healthcare Group, LP. (“Tyco”) on December 23, 2002, alleging infringement of U.S. Patent No. 5,348,544 (the “’544 patent”). The ‘544 patent is generally directed toward single-handed actuated safety shields used to prevent accidental needle sticks to health care workers.

2. Tyco asserted the defenses of invalidity for anticipation, failure to satisfy the written description requirement under 35 U.S.C. § 112, and inequitable conduct.<sup>1</sup> The court held a *Markman* hearing, and issued an order construing the disputed terms of the ‘544 patent on November 14, 2003. A jury trial commenced on October 18, 2004.

3 On October 26, 2004, the jury returned a unanimous verdict on all claims in favor of BD. The jury found that Tyco infringed the claims of the ‘544 patent, and that its infringement of the patent was willful. The jury also upheld the validity of the ‘544 patent, and awarded BD lost profits damages in the amount of \$4,204,423.00, royalty damages in the amount of \$236,498.00 for Tyco’s infringing Monoject Magellan safety needle devices, and royalty damages of ten cents per unit for Tyco’s infringing Monoject Magellan blood collector devices. The court entered judgment on the

---

<sup>1</sup> In a Memorandum and Order, dated September 16, 2004, the court found that the ‘544 patent was not anticipated by the prior art, thereby disposing of Tyco’s anticipation defense.

verdict on October 26, 2004.

4. Following the jury's verdict, Tyco filed a renewed motion for judgment as a matter of law ("JMOL"), as well as a motion for a new trial or to alter or amend the judgment under Federal Rule of Civil Procedure 59(e). BD filed a motion for enhanced damages, attorneys' fees, pre-judgment interest and post judgment interest, and a motion for a permanent injunction. On, March 31, 2006, the court issued a Memorandum and Order (D.I. 295), denying Tyco's motion for JMOL, denying Tyco's motion for reconsideration of the court's claim construction, and granting Tyco's motion for a new trial, based on a new infringement theory BD raised during the course of the trial.<sup>2</sup> On December 8, 2006, the court scheduled the re-trial to commence on November 27, 2007.

5. On February 23, 2007, Tyco initiated an ex-parte re-examination proceeding in the United States Patent and Trademark Office, based on a newly discovered prior art Dutch patent. On September 4, 2007, the patent examiner issued an office action, rejecting some of the '544 patent claims and allowing others. In the office action, the patent examiner stated that the "spring means" limitation should be interpreted under 35 U.S.C. § 112, ¶ 6 as a means-plus-function claim.

6. On September 25, 2007, Tyco filed a motion asking the court to adopt the patent examiner's claim construction. After considering the parties' briefing, as well as the arguments presented at a second pre-trial conference, the court denied this motion in a November 21, 2007 Order (D.I. 331). The basis for the court's denial was three-fold: (1) the re-examination proceeding was in its early stages at the time of Tyco's motion; (2) the court was concerned with the amount of time that would elapse between the patent examiner's initial determination and the conclusion of the re-examination

---

<sup>2</sup> The court also denied BD's motion for enhanced damages, attorneys' fees, pre-judgment interest and post judgment interest, and BD's motion for a permanent injunction.

procedure, which includes the possibility of an appeal; and (3) the court was not convinced that adopting the patent examiner's claim construction would result in an automatic judgment for Tyco and an immediate appeal.

7. The jury trial commenced on November 28, 2007. At the conclusion of BD's case, Tyco moved for JMOL as to infringement and willfulness. The court took the motions under advisement, and Tyco presented its defenses. At the close of all of the evidence, Tyco renewed both motions. The court granted the motion as to willful infringement and denied the motion as to infringement.

8. On November 30, 2007, the jury returned a verdict of infringement as to both of Tyco's products. On December 11, 2007, the court entered judgment for BD on the infringement issue. On December 20, 2007, Tyco filed a motion for a new trial and/or to alter the judgment pursuant to Federal Rules of Civil Procedure 59(a) and (e). This motion is presently before the court.

9. On December 4, 2007, BD filed its response to the September 4, 2007 office action. On January 10, 2008, the patent examiner rejected BD's argument, reasserted her construction of the "spring means" element, and made her action final.

10. Tyco's motion for a new trial asks the court to adopt the patent examiner's claim construction in the re-examination proceeding. More particularly, Tyco asks the court to revisit and reverse its claim construction of the term "spring means." Put differently, Tyco asks the court to find that the "spring means" claim term is a means-plus-function term. According to Tyco, once the court adopts the correct construction of the "spring means" term, it can then enter judgment for Tyco, because its products do not have the spring means element, as construed by the patent examiner.

11. Federal Rule of Civil Procedure 59(a) provides that:

[a] new trial may be granted to all or any of the parties and on all or part of the issues (1) in an action in which there has been a trial by jury, for any of the reasons for which new trials have heretofore been granted in actions at law in the courts of the United States . . .

It is within the discretion of the district court whether or not to grant a new trial. *Wagner v. Fair Acres Geriatric Ctr.*, 49 F.3d 1002, 1017 (3d Cir. 1995). Although Rule 59 does not detail the grounds on which a new trial may be granted, the following grounds have been recognized by the Third Circuit: “the verdict is against the clear weight of the evidence; damages are excessive; the trial was unfair; and that substantial errors were made in the admission or rejection of evidence or the giving or refusal of instructions.” *Lightning Lube, Inc. v. Witco Corp.*, 802 F. Supp. 1180, 1186 (D.N.J. 1992), *aff’d* 4 F.3d 1153 (3d Cir. 1993). When reviewing a motion for a new trial, a court must view the evidence in the light most favorable to the party for whom the verdict was returned. *Wagner v. Firestone Tire & Rubber Co.*, 890 F.2d 652, 656 (3d Cir. 1989).

12. The standard for obtaining relief under Rule 59(e) is difficult for a litigant to meet. A court may exercise its discretion to alter or amend its judgment if the movant demonstrates one of the following: (1) an intervening change in the controlling law; (2) a need to correct a clear error of law or fact or to prevent manifest injustice; or (3) the availability of new evidence not available when the judgment was granted. *North River Ins. Co. v. CIGNA Reinsurance Co.*, 52 F.3d 1194, 1218 (3d Cir. 1995).

13. In the present case, the court has already addressed the issues presented in Tyco’s motion for  
for  
a new trial and/or to alter the judgment at several junctures in this litigation: (1) during the *Markman*

hearing; (2) in its summary judgment opinion; (3) in its March 31, 2006 Memorandum and Order (D.I. 295) disposing of Tyco's request for reconsideration of the claim construction of the "spring means" element; and (4) in its November 21, 2007 Order (D.I. 331) denying Tyco's request to adopt the patent examiner's construction of the spring means term. Thus, Tyco's motion is simply another motion for reconsideration of the court's claim construction. Indeed, Tyco's post-trial briefing rehashes for the fifth time the same arguments that the court has already considered and rejected. As such, the court again rejects Tyco's attempt to reconstrue the "spring means" limitation. Insofar as Tyco's most recent bite at the apple raises the patent examiner's recent final office action construing the "spring means" limitation as a means-plus-function claim term, this information is not ripe for consideration. As Tyco aptly notes in its brief, "[t]he reexamination procedure is not necessarily over, as BD has the right to appeal." (D.I. 366, at 9 n. 5.) Thus, the prosecution history remains incomplete and the court, therefore, denies Tyco's newest motion for reconsideration of its claim construction ruling.

Therefore, IT IS HEREBY ORDERED that:

1. Tyco's Motion for a New Trial Under Rule 59(a) and/or to Alter or Amend the Judgment Under Rule 59(e) (D.I. 360) is DENIED.

Dated: September 11, 2008

/s/ Gregory M. Sleet  
CHIEF, UNITED STATES DISTRICT JUDGE