

Claim Construction in Interferences



Kristan Lansbery
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35 U.S.C. §135 (a)

- ... The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability....

Declaration of Interference

- An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa. 37 CFR §41.203

37 C.F.R. § 41.200(b) (2004)

- A claim shall be given its broadest reasonable construction in light of the specification of the application or patent in which it appears.
 - Similar text previously in 37 CFR §1.633(a)
 - August 12, 2004 until April 15, 2010
 - 75 Fed. Reg. 19,558 canceled this Rule

| Assignee | First Inventor | Numbers | Count | Earliest priority date |
|----------------------------|----------------|-------------------------|---|------------------------|
| Agilent Technologies, Inc. | Schembri | US Patent No. 6,513,968 | Patent issued Feb. 4, 2003 with Claim 20 | August 21, 1998 |
| Affymetrix, Inc. | Besemer | US Appl. No. 10/619,244 | Copied Claim 20, as Claim 66 in pending appl. | June 7, 1995 |

BPAI declared Interference February 6, 2006

Copied Claim

- A method comprising:
providing a first substrate and a second substrate having inner surfaces that define a closed chamber there between, said chamber adapted to retain a quantity of fluid so that the fluid is in contact with both inner surfaces, and wherein at least one of said inner surfaces is functionalized with polynucleotides, polypeptides, or polysaccharides;

Copied Claim cont.

- introducing a fluid containing a plurality of components into the closed chamber so as to provide a quantity of fluid therein in contact with both inner surfaces;
 - providing a bubble in the fluid; and
 - moving a bubble within the fluid to result in mixing.

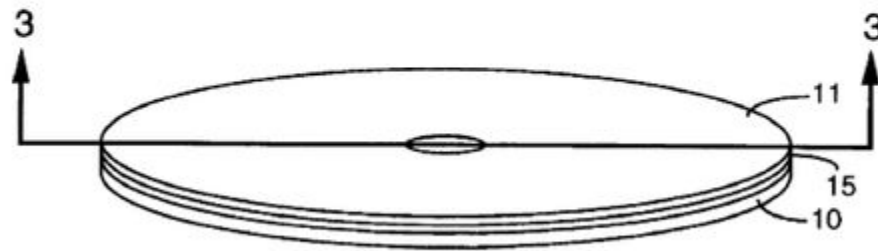


FIG. 1

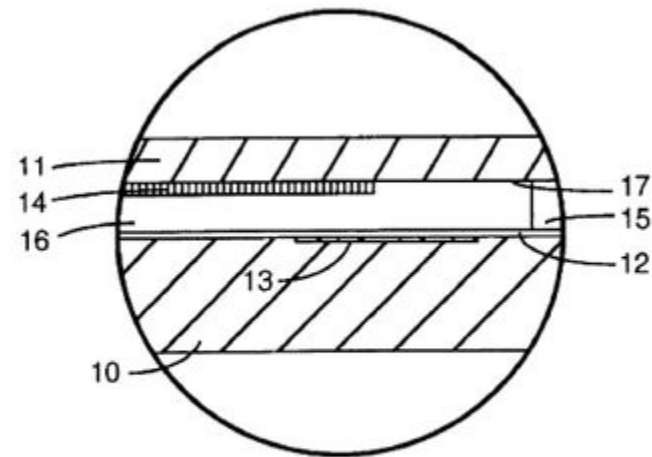


FIG. 4

Agilent's Schembri '968 Patent

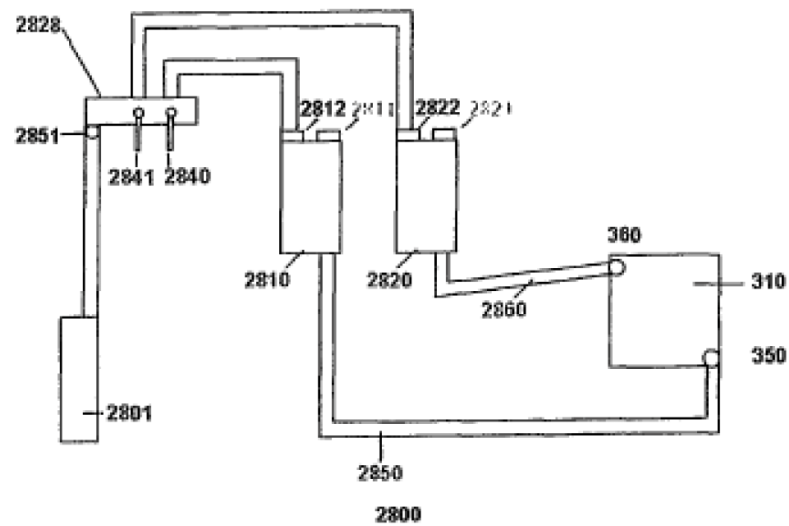


FIG. 28

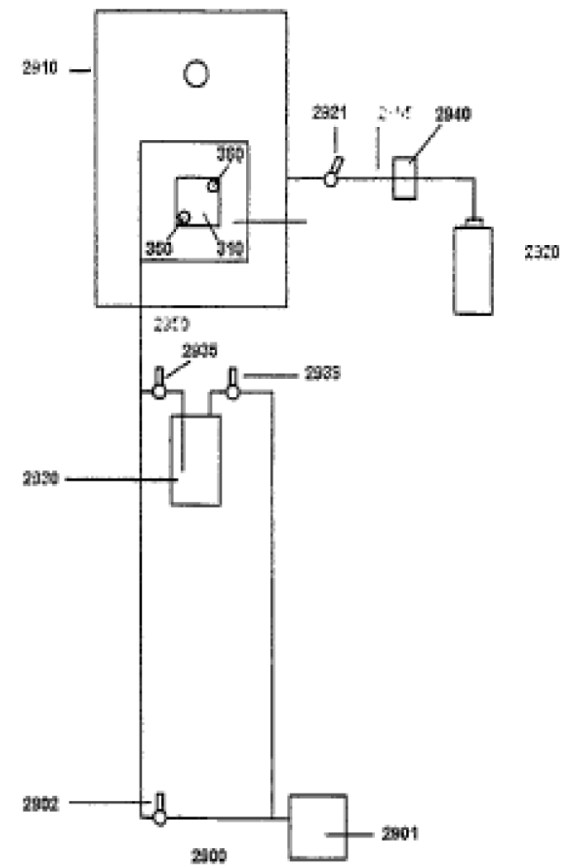


FIG. 29

Affymetrix's Besemer '244 application

Affymetrix vs. Agilent

- The BPAI held that Agilent did not show that mixing bubbles were not inherently disclosed to one of skill in the art by the Affymetrix application
- Appeal under 35 USC §146 so that new evidence could be entered. A claim construction hearing and summary judgment motions followed.
- District court affirmed BPAI that Besemer satisfied the written description requirement

In re Spina (1992)

- When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied.
- “*Spina* rule sought to ensure that the PTO would only declare an interference if both parties had a right to claim the same subject matter.” *Agilent v. Affymetrix*, (Fed. Cir. 2009)

Rowe v. Dror (1997)

- Issue is anticipation in light of third party patent, prior art to only the junior party
- Claim term construed in light of junior party (host) application
- Issue of “whether the patent claim is patentable to one or the other party in light of prior art.”

Agilent Tech., Inc. v. Affymetrix, Inc. (2009)

- Written description (*Spina*) use originating patent for claim/count construction
- Prior art challenge (*Rowe*) use specification in which claim appears
- CAFC expressly rejects argument by Affymetrix based on 37 CFR §41.200(b)

CAFC v. USPTO Smackdown

- *Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, No. 09-1241 (Fed. Cir. Jan. 5, 2010)
- “Any conflict between [*Agilent* and Rule 200(b)] must be resolved as directed in *Agilent*.”
- On April 15, 2010, 37 CFR § 41.200(b) was canceled



Issues Raised

- Written description as the outlier?
- What if the application with the copied claim wins the interference, the challenged patent is canceled? How is the copied claim interpreted for written description in a validity challenge?