

The Latest Intellectual Property News



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Welcome to The Latest Intellectual Property News, a newsletter for updating you with recent information about Intellectual Property.

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NO DESCRIPTION OF FULLY HUMAN AB WITH AFFINITY TO IL-12

By Sean A. Passino, Ph.D., Esq./Partner (spassino@jpfirm.com)

A United States Court of Appeals for the Federal Circuit panel of two (a third Circuit Judge expressed no opinion on this issue) affirmed a jury verdict finding that claims directed to fully human antibodies that are defined by their affinity and activity to a known antigen (IL-12) lacked written description support. *AbbVie Deutschland GmbH & Co. V. Janssen Biotech, Inc.*, Slip op. 13-1338 (Fed. Cir. Jul. 1, 2014). The written description requirement is that a patent applicant must describe his invention so that the public will know what it is and that he has truly made the claimed invention. Here, the claims define a genus, but the specification merely describes a part of that genus that is insufficient to constitute a description of the genus.

In these circumstances, the fact finders are to consider the extent and content of the prior art, the maturity of the science or technology, and the predictability of the aspect at issue. *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005). When a patent claims a genus using functional language to define a desired result, “the specification must demonstrate that the applicant has made a generic invention that achieves the claimed result and do so by showing that the applicant has invented species sufficient to support a claim to the functionally-defined genus.” *Id.* “[A] sufficient description of a genus . . . requires the disclosure of either a representative number of species falling within the scope of the genus or structural features common to the members of the genus so that one of skill in the art can ‘visualize or recognize’ the members of the genus.” *Id.*

Here, AbbVie admitted that the relevant patents do not disclose structural features common to the members of the claimed genus. The claims embrace a structurally diverse set of antibodies but the base patent describes one subtype. For example, the patent describes Joe-9 derivatives having a V_H3 heavy chains and Lambda light chains. The CDRs of the disclosed Joe-9 derivatives have 90% sequence identity. Not described, but embraced by the claims, is Centocor’s Stelara, which has V_H5 heavy chains and Kappa light chains. Stelara’s CDR has 50% sequence identity to that for the disclosed Joe-9 derivatives. The Federal

Circuit cited evidence that antibodies having 80% sequence identity “could bind to different antigens” and are therefore unpredictable. The Federal Circuit also noted, in the affinity and binding data, a lack of a structural-functional correlation.

Interestingly, the Federal Circuit stated, “the patents must at least describe some species representative of antibodies that are structurally similar to Stelara.” Here, the consequence is invalidity.

REQUEST TO CONSIDER STIPULATED CONSTRUCTION HELD TO BE DISCLAIMER

By Michael P. McComas (mmccomas@ipfirm.com)

A Federal Circuit panel affirmed a district court’s grant of summary judgment that Apple Inc. (Apple) did not infringe two patents asserted by Golden Bridge Technology, Inc. (GBT) since GBT was bound to a stipulated claim construction by its submission during prosecution of the patents at issue. *Golden Bridge Technology, Inc. v. Apple Inc.*, slip op. 2013-1496 (Fed. Cir. July 14, 2014).

The claims asserted against Apple are from a reexamination of U.S. Patent No. 6,574,267 (“’267 patent”) and U.S. Patent No. 7,359,427 (“’427 patent”), a continuation of the ‘267 patent. Prior to the reexamination, the ‘267 patent had been the subject of litigation, in which GBT’s stipulated claim construction included a limited interpretation of a transmission preamble. Because GBT expressly requested that the USPTO consider this stipulated construction in IDS submissions during reexamination of the ‘267 patent and prosecution of the ‘427 patent, the panel held that GBT’s request constituted a disclaimer of a broader interpretation of a preamble.

The panel, citing precedent, noted that “mere disclosure of potentially material prior art to the [PTO] does not automatically limit the claimed invention,” but that GBT had made a clear assertion as to the meaning and scope of the term preamble. The panel also noted that GBT could have rescinded the disclaimer during prosecution but did not do so.

NO ADDITIONAL LIMITS ON EVIDENCE IN §146 INTERFERENCE APPEAL

By Sean A. Passino, Ph.D., Esq./Partner (spassino@ipfirm.com)

The Federal Circuit held that the United States Supreme Court’s decision in *Kappos v. Hyatt*, 132 S. Ct. 1690 (2012) permits new evidence to be admitted without regard to whether the issue was raised before the Board. *Troy v. Samson Manufacturing Corp.*, slip. op. 13-1565 (Fed. Cir. Jul. 11, 2014). Troy was a junior party in an interference. After failing to convince the Board of an actual reduction to practice, the Board entered judgment against Troy and canceled his patent. Troy appealed to the district court under §146.

In the district court, Troy proffered new evidence, including the declaration of Conley and affidavit of Chin. The district court refused to consider the new evidence, because a “party is generally precluded from raising issues or theories of law in a Section 146 proceeding that were not previously raised before the board.” The district court entered judgment against Troy.

The Federal Circuit reversed, relying on *Hyatt’s* holding that “there are no limitations on a patent applicant’s ability to introduce new evidence in a § 145 proceeding beyond those already present in the Federal Rules of Evidence and the Federal Rules of Civil Procedure.” *Kappos v. Hyatt*, 132 S. Ct. 1690, 1700–01 (2012). Contrary precedent, see, e.g., *Conservolite v. Widmayer*, 21 F.3d 1098, 1102 (Fed. Cir. 1994), was overruled as inconsistent with Supreme Court authority. The Federal Circuit stated that “the Supreme Court’s decision ought not to be read to create an evidentiary chasm between § 145 and §

146.”

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