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Agilent Tech., Inc. v. Affymetrix, Inc.

Decided June 4, 2009

Originating disclosure relied upon to provide the meaning of claim language in interferences

In this case, the Federal Circuit addressed whether, in an interference proceeding, one looks to the specification *from* which claims were copied, or the specification *to* which claims were copied, for purposes of determining whether the copied claims satisfy the written description requirement.

U.S. Patent No. 6,513,968, issued on February 4, 2003, was assigned to Agilent. U.S. Patent Application No. 10/619,244 was assigned to Affymetrix. Affymetrix copied the claims of the '968 patent into the '244 patent application in order to provoke an interference. The Board of Patent Appeals and Interferences (BPAI) declared Affymetrix the senior party in the interference due to a claim of priority to a parent application. The U.S. District Court for the Northern District of California affirmed the BPAI.

The Federal Circuit reversed the District Court. The Federal Circuit found that the '244 patent application did not satisfy 35 U.S.C. § 112, first paragraph. The Federal Circuit applied *Rowe v. Dror*, 112 F.3d 473 (Fed Cir. 1997), which held that during an infringement proceeding, when the issue is whether the claim is patentable to one or the other party in light of the prior art, the validity of an applicant's claims are evaluated with reference to the host specification. The Federal Circuit distinguished from *In re Spina*, 975 F.2d 854 (Fed. Cir. 1992), which applies when the issue is whether both parties have a right to claim the subject matter. In such a case, claim construction occurs in the context of the specification from which the claims were copied.

Practice Tip: Written description requirements are particularly important in cases like this one where one party copies claims from another patent document in order to provoke an interference. In interferences, a court will look at the originating disclosure to provide the meaning of the pertinent claim language.