

A blue graphic element containing the text "http://www" in a white, sans-serif font.

# R.E. Bushnell & Law Firm

## Newsletter

Claim Construction Considered by US CAFC

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### Claim Construction Considered by US CAFC

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##### 1. Claim Construction Considered by US CAFC

*By Robert E. Bushnell and Henry Zykorie*

In a decision published on June 4, 2009, Agilent Tech., Inc. v. Affymetrix, Inc. (Fed. Cir. 2009), the US Court of Appeals for the Federal Circuit considered the decision of a Federal District Court (N.D. California District Court), with regard to claim construction vis-à-vis claim interpretation in light of the written description.

This matter arose in connection with the Appellee, Affymetrix amending its pending application by adding claims copied from Appellants', Agilent Tech., Inc. issued patent to provoke an interference.

The Appellants' patent had a priority date of 1998 while the Appellees' application claims priority back to 1995. Accordingly, the US Patent and Trademark Office Board of Patent Appeals and Interferences (BPAI) awarded priority to the Appellee in 2006. The BPAI holding was upheld by a Federal District Court (N.D. California District Court) in 2008.

The CAFC reverses the Federal District Court decision, holding that the Appellee cannot claim priority back to the 1995 filing of the original application since the original application "does not satisfy the written description requirement for the claims at issue."

The question as to the adequacy of the written description oftentimes arises when claims are copied by a second application or patent from a first application or patent to provoke an interference.

In determining the adequacy of the written description, a decision must be made as to whether the written description of the second application or patent is to be used in determining the adequacy of the written description or whether the written description of the first application or patent is to be used in determining the adequacy of the written description.

Previously, the CAFC reached different conclusions based on the specific facts of the case.

Namely, in In re Spina, 975 F.2d 854 (Fed. Cir. 1992), the CAFC held that for the purpose of the written description requirement, the newly added claims should be interpreted based on the specification and history of the opposing source application or patent.

On the other hand, in Rowe v. Dror, 112 F.3d 473 (Fed. Cir. 1997), the CAFC held that for the purposes of novelty and non-obviousness, the newly added claims should be construed based on the specification and history of the amended application or patent.

Stated differently, in Spina, when a party challenges written description support for an interference count or the copied claim an interference, the originating disclosure must be used to interpret the pertinent claim language while in Rowe, when a party challenges a claims validity under 35 USC 102/103, the copied claim must be interpreted in light of the specification in which the copied claim appears.

In this decision, the CAFC chose to follow both the Spina and Rowe decisions and to interpret the copied claim based on the specific fact situation.

That is, as stated by the CAFC: "This case calls for application of the Spina rule, because the question is "whether the copying party's specification adequately supported the subject matter claimed by the other party. ... This case does not present the Rowe situation,"where the issue is whether the claim is patentable to one or the other party in light of the prior art." (Citations omitted).

In view of the above, the CAFC reversed the Federal District Court decision, holding that the Appellee cannot claim priority back to the 1995 filing of the original application since the original application "does not satisfy the written description requirement for the claims at issue."

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