

CLIENT ALERT

Federal Circuit's Broad Claim Construction Defeats Patent Owner's Infringement Claim

MAY 15, 2019

BTG International Limited, et al. v. Amneal Pharmaceuticals LLC, et al., Nos. 2019-1147, 2019-1148, 2019-1323, 2019-1324, and 2019-1325 (Fed. Cir. May 14, 2019)

The patent owner sued the accused infringers, asserting that the accused infringers' generic version of the patent owner's product infringed all claims of the patent. The accused infringers filed three, separate *inter partes* review (IPR) petitions. In all three IPRs, the Patent Trial and Appeal Board (PTAB) issued claim construction orders adverse to the patent owner and found the asserted claims obvious. The district court found all asserted claims invalid as obvious in light of its claim construction and the same combination of prior art relied on by the PTAB. The Federal Circuit affirmed.

The asserted claims concerned a method for the "treatment" of prostate cancer by administering "a therapeutically effective amount" of abiraterone and prednisone. The patent owner argued that the PTAB improperly construed the term "treatment" by not requiring prednisone to have an anti-cancer effect. The Federal Circuit disagreed with the patent owner, concluding that the "patent's claims, specifications, and prosecution history teach that 'treatment' includes both anti-cancer effects and palliation or reduction in side effects of a different anti-cancer drug." The Federal Circuit noted that the specification states that a "therapeutic agent" may be either "an anti-cancer agent or a steroid." It further states that prednisone is both a steroid and an anti-cancer agent, which supports the PTAB's construction that prednisone may "treat" cancer by either having anti-cancer effects or by producing "familiar steroid effects of palliation and the reduction of side effects cause by the co-administration of abiraterone." Furthermore, the Federal Circuit held that substantial evidence supported the PTAB's obviousness determination that the prior art provides "a reasonable expectation of success" that prednisone could be therapeutically effective in the treatment of prostate cancer.

[A copy of the opinion can be found here.](#)

1 Min Read

Authors

[David Enzminger](#)

[Ivan Poullaos](#)

Mike Rueckheim

Danielle Williams

Related Locations

Charlotte

Chicago

Los Angeles

Silicon Valley

Related Topics

Markman/Claim Construction

Inter Partes Review (IPR)

Patent Trial and Appeal Board (PTAB)

Related Capabilities

Patent Litigation

Intellectual Property

Related Regions

North America

Related Professionals



David Enzminger



Ivan Poullaos



Mike Rueckheim



Danielle Williams