

## Federal Circuit Vacates District Court Claim Constructions that Excluded Disclosed Embodiments

SEPTEMBER 30, 2020

*Baxalta Inc. v. Genentech, Inc.*, No. 2019-1527 (Fed. Cir. Aug. 27, 2020)

The Federal Circuit vacated claim constructions of Judge Dyk, who sat by designation at the district court.

The patent owner sued the defendants for infringing U.S. Patent No. 7,033,590. The parties contested claim constructions of “antibody” and “antibody fragment.” The district court used the specification and the prosecution history to adopt the narrower constructions proposed by the defendants. The Federal Circuit vacated the constructions and remanded.

Regarding “antibody,” the Federal Circuit held that the narrower construction was inconsistent with the plain language of the claims. The narrower construction also excluded embodiments in several dependent claims, a factor that “weighs heavily” in favor of the broader construction. The Federal Circuit rejected the possibility that the patent examiner simply overlooked inconsistent dependent claims during prosecution. The panel also reasoned that while one part of the specification supported the narrower claim construction, the specification *as a whole* supported the broader construction.

The district court also interpreted an amendment in the prosecution history changing “antibody derivative” to “antibody fragment” as a narrowing amendment that informed the scope of “antibody.” The Federal Circuit held that this amendment did not rise to the level of a “clear and unmistakable” prosecution disclaimer. Instead, the applicant merely substituted interchangeable phrases.

Regarding “antibody fragment,” the Federal Circuit held that the district court misinterpreted a passage from the specification as a definition. The passage used the phrases “may also include” and “such as.” Therefore, the passage failed to meet the exacting lexicography standard that requires a patentee to clearly express an intent to redefine a term.

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