

ARE ALL PANELS OF THE FEDERAL CIRCUIT FOLLOWING AGILENT AND PHILIPS?¹

By

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Introduction

Agilent Technologies, Inc. v. Affymetrix, Inc., 567 F.3d 1366, 91 USPQ2d 1161 (Fed. Cir. 2009)(hereinafter referred to as “Agilent”)(opinion by Circuit Judge Rader for a panel that also consisted of Circuit Judge Mayer and Circuit Judge Posner of the Seventh Circuit, sitting by designation),³ held that a “copied” claim⁴ can be interpreted in one way for one purpose and in another way for another purpose—i.e., that such a claim can mean one thing in deciding one motion and mean something very different in deciding another motion. Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co., 590 F.3d 1326, 93 USPQ2d 1227 (Fed. Cir. 2010)(hereinafter referred to as “Philips”)(opinion by Circuit Judge Gajarsa, joined by Chief Circuit Judge Michel and Senior Circuit Judge Friedman),⁵ emphatically reaffirmed Agilent’s holding. Still more recently, Robertson v. Timmermans, ____ F.3d ___, ____ USPQ2d ____ (Fed. Cir. 2010)(hereinafter referred to as “Robertson”)(opinion by Circuit Judge Plager for a panel that also consisted of Circuit Judges Linn and Dyk), rev’g Robertson v. Timmermans, 90 USPQ2d 1898 (PTO BPAI 2008)(non-precedential)(opinion by APJ Lee for a panel that also consisted of APJs Schafer and Tierney)⁶ again reaffirmed the rule in Agilent.

However, the Federal Circuit’s opinions in Yorkey v. Diab, ____ F.3d ___, 94 USPQ2d 1435 (Fed. Cir. 2010)(hereinafter referred to as “Yorkey I”)(opinion by Chief Circuit Judge Michel for a panel that also consisted of Circuit Judge Gajarsa and District Judge Kendall of the U.S. District Court for the Northern District of Illinois, sitting by designation); Yorkey v. Diab,

____ F.3d ___, 94 USPQ2d 1444 (Fed. Cir. 2010)(hereinafter referred to as “Yorkey II”)(opinion by Chief Circuit Judge Michel for a panel that also consisted of Circuit Judge Gajarsa and District Judge Kendall); and Rolls-Royce, PLC v. United Technologies Corp. ____ F.3d ___, ____ USPQ2d ____ (Fed. Cir. 2010)(hereinafter referred to as “Rolls-Royce”)(opinion by Circuit Judge Rader for a panel that also consisted of Chief Circuit Judge Michel and Circuit Judge Schall), raise the question of whether all panels of the Federal Circuit (including panels the membership of which overlaps with the membership of the panels in Agilent and Philips) are following Agilent and Philips).

The Facts in Yorkey I and Yorkey II

In both cases, Yorkey was a junior party patentee, and Diab was a junior party applicant. In Yorkey I, Yorkey was involved on its patent No. 5,645,060, and Diab was involved on its application S.N. 09/110,542. In Yorkey II, Yorkey was again involved on its patent No. 5,645,060 , but Diab was involved on its application S.N. 09/111/604.

In Yorkey I, there were two non-McKelvey counts. Yorkey’s claims 1, 2, 8, and 12-16 and Diab’s claims 15, 19, and 20 were designated as corresponding to count 1. Yorkey’s claims 3-5, 7, 10, 11, and 17 and Diab’s claims 16-18 and 21 were designated as corresponding to count 2.

In Yorkey II, there was a single McKelvey count consisting of the Boolean union of Yorkey’s claim 6 and Diab’s claim 38.

In Yorkey I, Yorkey had filed four motions. Although the court’s opinion is not clear on this point, apparently one of those motions was a motion for a judgment that Diab’s claims corresponding to count 1 were unpatentable for lack of written description, and one of those motions was a motion for a judgment that Diab’s claims corresponding to count 2 were

unpatentable for lack of written description.⁷ A panel of the board denied both of those motions, and Yorkey appealed.

In Yorkey II, Yorkey had filed two motions. One of those motions was a motion for a judgment that Diab's claims corresponding to the single count were unpatentable for lack of written description.⁸ A panel of the board denied that motion, and Yorkey appealed.

Unfortunately, the court's opinion does not quote any of the claims involved in Yorkey I, nor does it explain the precise relationship of those claims to either of the non-McKelvey counts. Moreover, despite the fact that the issue before the board had been the patentability of the claims corresponding to the counts, the court only analyzed the written description issue as applied to the language of the counts, without explaining how that analysis applied to the language of Diab's claims.

In its opinion in Yorkey II, however, the court quoted lengthy passages from Yorkey's claim 6 and Diab's claim 39.⁹ Those passages make it very, very clear that at least Diab's application claim 39 was very closely modeled on and used much of the same language as Yorkey's patent claim 6. That is, Diab's application claim 39 was a "copied" claim as that term of art is used in interference law.

The Absence of Reference in Either Yorkey I or I or Yorkey II to Either Agilent or Philips

Although both Chief Circuit Judge Michel and Circuit Judge Gajarsa had been on the panel in Philips, neither Yorkey I nor Yorkey II mentions Philips—or, for that matter, Agilent or any of the predecessors to Agilent and Philips discussed at length in those opinions.

What are we to make of this fact?

I submit that there are two possibilities.

The first possibility is that Diab's claims involved in Yorkey I were, like Diab's claims

involved in Yorkey II, not identical to Yorkey’s claims and that Their Honors did not realize that a claim could be “copied” for interference purposes even though it was not word-for-word identical to the target claim. That of course suggests that Their Honors were unfamiliar with one of the basic tenets of modern interference practice.¹⁰

The second possibility is that Their Honors were *sub silentio* limiting Agilent and Philips to claims copied in ipsissimis verbis. That, however, hardly seems likely—since imposing such a major limitation on two so recently decided (and very controversial—at least among the members of the interference bar¹¹) opinions *sub silentio* would not be good judicial practice.

The Facts in Rolls-Royce

Rolls Royce was an appeal from a 35 USC 146 action brought to review a decision in a patent-application interference. The opinion says that “This court gives pending claims in interference proceedings their broadest reasonable construction in light of the specification”¹²—without saying which specification or why it was using that specification to interpret the claims in which case in interference. However, the court then interpreted the applicant’s claims in light of the applicant’s specification despite the fact that the applicant’s claims were “copied from” (i.e., were modeled on) the patentee’s claims.

Of course, Rolls-Royce is distinguishable from Agilent, Philips, and Robertson (which was decided the same days as Rolls-Royce) because the motion in question was a motion for a judgment of no-interference-in-fact rather than a motion for a judgment of unpatentability for lack of written description. However, I believe that the fact that the identical claim is interpreted differently for those two types of motions highlights one of the problems with the Agilent rule. Specifically, Agilent says that the reason the copier’s claims should be interpreted in light of the specification from which they were copied in deciding a written description motion is to insure

that parties have a right to claim the same invention.¹³ However, the purpose of a motion for a judgment of no-interference-in-fact is to insure that the parties are, in fact, claiming the same invention. So, if the purpose of the two types of motions is so similar, why should the copier's claims be interpreted differently in the two situations?

Comment

IMHO, Yorkey I, Yorkey II, and Rolls-Royce are further evidence of the fact that the whole issue of multiple, differing interpretations of the same claim cries out for reconsideration by the Federal Circuit en banc.

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³ Discussed in Gholz, How Should “Copied” Claims Be Interpreted?, 16 Intellectual Property Today No. 9 at page 11 (2009), and Gholz, A Critique of Recent Opinions in Patent Interferences, 92 JPTOS 1 (2010) at § XI.A.

⁴ “Copied” is a term of art in interference law. It does not mean that the targeting claim is necessarily word-for-word identical to the targeted claim. What it means is that the targeting claim is based on the targeted claim and at least allegedly interferes with the targeted claim. See, e.g., Kubota v. Shibuya, 999 F.2d 517, 521-22, 27 USPQ2d 1418, 1422 (Fed. Cir. 1992)(“Under the present rules[,] an applicant is not required to copy a patent’s [or a targeted application’s]

claims exactly, and the applicant need only present claims drawn to the same patentable invention as the ‘count’ of the interference.”), quoting Heymes v. Takaya, 6 USPQ2d 2055, 2056 (PTOBPAI 1988), with approval.

⁵ Discussed in Gholz, Are Agilent and Philips Limited to Claims Copied in *Ipsissimis Verbis?*, 17 Intellectual Property Today No. 5 at page ___ (2010).

⁶ Discussed favorably in Gholz, A Critique of Recent Opinions in Patent Interferences, 92 JPTOS 1 (2010) at § XI.B.

⁷ The other two motions were irrelevant to the subject under discussion here.

⁸ The other motion was irrelevant to the subject under discussion here.

⁹ ___ F.3d at ___, 94 USPQ2d at 1446.

¹⁰ That this may well be the case is suggested by multiple infelicities of language in the opinions:

- (1) Yorkey I describes Diab’s motions as a “motion seeking invalidity of [Diab’s] claims,” ___ F.3d at ___, 94 USPQ2d at 1436, rather than as a motion for a judgment that Diab’s claims were unpatentable;
- (2) Yorkey I also describes Diab’s motions as “seeking to have Diab’s claims corresponding to Counts 1 and 2 denied,” ___ F.3d at ___, 94 USPQ2d at 1437;
- (3) Yorkey I refers to the board as “the court,” ___ F.3d at ___, 94 USPQ2d at 1439;
- (4) Yorkey I asserts that “Yorkey...argues that the Board erred in holding that he failed to establish a prima facie case that he had reduced Count 1 to practice prior to Diab’s benefit date...,” ___ F.3d at ___, 94 USPQ2d at 1441 (emphasis supplied), rather than that he argued that the board had erred in holding that he had failed to establish that he had reduced subject matter within the scope of count 1 to practice prior to Diab’s benefit date; and

(5) Yorkey II asserts that “The Board...awarded priority to the Diab application and invalidated the Yorkey patent,” ____ F.3d at ___, 94 USPQ2d at 1446.

¹¹ Note that, at the urging of its Interference Committee, in Agilent the AIPLA filed an amicus brief in support of Affymetrix’s petition for rehearing en banc.

¹² Citing Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 499, 42 USPQ2d 1608, 1611-12 (Fed. Cir. 1997), and 37 CFR 41.200(b)—despite the fact that, by the time the opinion came down, the PTO had cancelled 37 CFR 41.201(b) in deference to Agilent and Philips!

¹³ Agilent cited Rowe v. Dror, 112 F.3d 472, 42 USPQ2d 1550 (Fed. Cir. 1997), which discussed In re Spina, 975 F.2d 854, 24 USPQ2d 1142 (Fed. Cir. 1992), and asserted that it (i.e., Rowe) was merely adopting the rule in that case. It explained that “This *Spina* rule sought to ensure that the PTO would only declare an interference if both parties had a right to claim the same subject matter.” 112 F.3d at 479, 42 USPQ2d at 1554.